REMARKS

Claims 126-142 are pending in the present application. Claims 131, 136, and 142 have been amended. Claims 126-142 remain in the application.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 126-142 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,557,723 to Holt, et al. ("Holt") and in view of U.S. Patent No. 6,460,042 to Hitchcock, et al. ("Hitchcock").

Applicant respectfully traverses the rejection of claims 126-142 under 35 U.S.C. § 103 for the reasons set out below. The prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application. Turning first to claim 126,

> To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Regarding independent claim 126, Holt in view of Hitchcock fails to teach at least the limitation of "providing a graphical user interface to the user to allow the user to identify actions to be associated with the identified input fields, the provided user graphical user interface being dependent on the identified input fields," and the limitation of "automatically generating a program code to carry out the actions identified by the user." Hitchcock is clearly irrelevant to these limitations, nor is it purported by the Examiner that Hitchcock teaches or suggests these limitations.

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-6-

Holt is directed to creating custom email forms. Holt not only does not teach "automatically generating a program code to carry out the actions identified by the user," it expressly teaches away from this limitation. The Examiner purports that Holt teaches this limitation at Column 2 Lines 45-53. In these lines, Holt describes the FCP, the Form Control Procedure, which is a subroutine that implements user-defined processing of the form. However, the FCP is expressly described as being "written [i.e., generated] by the forms designer." *See* Holt, at Column 5 Lines 56-57. Therefore, Holt clearly teaches away from automatic generation of the program code that carries out the custom actions identified by the user.

The Examiner furthermore purports that Holt teaches "providing a graphical user interface to the user to allow the user to identify actions to be associated with the identified input fields, the provided user graphical user interface being dependent on the identified input fields" at Column 2 Lines 1-5 and Figure 3. The cited passage merely states that an object of Holt is to provide an email system in which a user can specify the field layout of a custom form and can specify the behavior of the fields. Figure 3 merely illustrates how the custom form will be displayed to a recipient or user of the form.

Thus, Holt does not teach or suggest "providing a graphical user interface to the user to allow the user to identify actions to be associated with the identified input fields," and even more particularly does not teach or suggest that "the provided user graphical user interface [is] dependent on the identified input fields." In fact, Holt states that "the FCP [the Form Control Procedure that is the program code that controls the behavior of the fields] is written by the forms designer to implement form customization." *See* Holt at Col. 5 Lines 56-57 (emphasis added). An element of a data structure into which code can be written is not a graphical user interface. Furthermore, the interface does not

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-7-

depend of the custom input fields of the custom form, but is merely a standard programming interface.

The line from Column 5 of Holt cited above further demonstrates that Holt expressly teaches away from "automatically generating a program code to carry out the actions identified by the user," as discussed above The user must write the code him/herself in Holt. The passage cited by the Examiner for this limitation – Column 2 Lines 44-57 – merely states that the user can specify an FCP to control the behavior of the form components. Thus, as set forth further above, Holt nowhere teaches automatic generation of the FCPs. In fact, Holt expressly teaches away from this limitation.

In light of the above observations and arguments, it is apparent that independent claim 126 is allowable and should now be allowed. Furthermore, independent claims 132 and 137, which contain similar limitations, should also now be allowed. In addition all claims depending on these allowable independent claims and adding further limitations should also be allowed.

Furthermore, regarding dependent claims 131, 136, and 142 in particular, the Examiner purport that Holt teaches periodic consistency checking at Column 5 Lines 12- 15. In this passage, Holt merely states that a field, i.e., a value, can be updated by calling the FCP from time to time. This does not teach automatically checking the consistency of the form itself with the program code that is automatically generated in the present invention. Furthermore, since Holt does not teach this limitation, generating an alert to show an inconsistency cannot be an obvious addition. Thus, Holt does not only fail to teach limitations of the base claims, but also of these dependent claims.

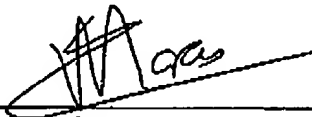I:\INSTANTIS, INC\P001\Amend_Resp_FOA_due 8.9.03.doc

-8-

Therefore, all claims presently pending – claims 126 to 142 – should now be allowed.

If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact André L. Marais at (408) 947-8200 ext. 204.

If there are any additional charges, please charge them to Deposit Account No. 02-2666.

Respectfully submitted,
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Dated: _____07/24_, 2003 _____

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-9-